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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,804	10/01/2001	Holger Hauptmann	0475-0193P	6560
2292	7590	11/17/2004		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				EXAMINER
				HOFFMANN, JOHN M
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/890,804.	HAUPTMANN ET AL.
	Examiner John Hoffmann	Art Unit 1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 October 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,4,5,10 and 22-25 is/are pending in the application.
 - 4a) Of the above claim(s) 22-25 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4,5 and 10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 September 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/7/04 has been entered.

Election/Restrictions

Claims 22-25 remain withdrawn from consideration as being directed to a non-elected invention.

From MPEP 819 Office Generally Does Not Permit Shift:

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right). When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 4-5 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner could find no support for method as claimed in claim 1. Most notably the new limitation that the movable supports are operatively connected to a support structure alone, and/or in combination with the rest of the claimed limitations. From the drawings and disclosure, the support structure is merely in wadding or are on top of other structure – no mention of any connection. This is deemed to be a *prima facie* showing of lack of support. The burden is now on Applicant to demonstrate support.

Furthermore, Examiner did a text search of the present specification – there is no indication as to anything being connected to anything else.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,2, 4 , 5, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “operatively connected” is indefinite as to its meaning, because it is not understood how applicant’s apparatus constitutes operatively connected structures, but Thurnauer’s arrangement lacks operatively connected features. It seems to Examiner that applicant is using some non-standard definition for “operatively connected” and since it is unclear what that definition is, the claims fail to inform one as

to what is meant. Furthermore, it doesn't seem like the things are connected if the supports move with respect to the support structure as claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-5, and 10 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Thurnauer 3904352.

Looking to figure 2: 2 is the firing material. 12-12 plus 8-8 are the movable supports. They adapt independently as claimed (col. 4, lines 15-20). The firing material is sintered (col. 1, lines 23-24). The supports are inert: col. 3, lines 43-54. There is no adhesion or contamination (col. 3, lines 55-59). If such things are not disclosed: it would have been obvious to one of ordinary skill to not permit any adhesion or contamination – because the purpose of Thurnauer is to create the final body, and not have anything extra in it (such as a contaminate or kiln furniture).

As to the “operatively connected” limitation: as indicated above, Examiner is not sure what is meant by such. But it is deemed that Thurnauer’s method meets the limitation in as much as applicant’s invention does. The moveable supports 12-12 move with respect to the base, but not with respect to the contacting portions.

Claim 2: The limitation that the items are dental prostheses, is an intended use.. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Whether someone wishes to use the Thurnauer as a dental prosthesis for an elephant, is merely an intention. It would seem to be a very bad prosthesis, nevertheless, someone could make it for that intention. Likewise, Applicant’s pre-shaped items would make very bad prostheses. It is not until they are sintered that they would be very useful; it is the final-shaped (i.e. fired) bodies which one would most likely use.

Claim 5: the supporting materials comprise tips which meet the claim language. The upper surfaces of the spheres 8 are deemed to be the tips. They have a minimal contact surface with the body 2. The surface area contact surface would be zero. There is no real minimal surface area that is more minimal than “zero”. It is noted that

the claim is comprising in nature and thus it is open to other surfaces with a non-minimal contact surface.

Alternatively: as to a tip “allowing” a minimal surface. The contact tips of the spheres allow (i.e. permits) a minimal contact surface on the side of the body 2. In other words, the Thurnauer tips do not block access the side of the body 2, and thus they permit/allow any sort of contact – such as a minimal contact surface.

Claim 10: the very different physical properties include: shape, heat resistance and composition. (col. 3, lines 43-54).

Claim 4 refers to the materials being developed. It is noted that this is not recited like the step of “resting”. There is no step of “developing”. Claims are given their broadest reasonable interpretation. It does not seem reasonable to interpret the claims as having a step of developing. And a much broader scope would be that the claim merely indicates how the materials were developed – i.e. it is a product by process limitation. “—patentability of a claim to a product does not rest merely on a difference in the method by which that product is made. Rather, it is the product itself which must be new and unobvious.” (In re Pilkington, 162 USPQ 147). The Thurnauer materials are essentially identical to materials that were developed vertically or horizontally lying rods. One cannot tell how the Thurnauer materials were made/developed. Thus they are the same as features developed as claimed.

Drawings

The drawings were received on 7-10-04. These drawings are not approved – because Examiner could not tell what changes were made.

The drawings remain objected to under 37 CFR 1.84 (p) 4.

Examiner forgot to include the following paragraph:

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Examiner apologizes for the oversight.

Information Disclosure Statement

The information disclosure statement filed 7 October 2004 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

Three references were not considered because they were not properly listed: they lacked dates. It is noted that these three documents have notation that they were printed in 2002. Also it is noted that "078/98" and "97/98" are not dates.

Response to Arguments

Applicant's arguments filed 7 October 2004 and 9 September 2004 have been fully considered but they are not persuasive.

It is argued that the Office has already performed a search. Examiner is interpreting this to be an argument that a search was done on the non-elected invention. There is no evidence or rationale to support this position. Examiner did not do such a search and Examiner could not see any evidence that the previous examiner searched for it.

It is also argued that there is no undue burden on the Office. There was no evidence or rationale to support this position.

It is argued that claim 1 has already been searched. This is true. And if claim 1 or any other generic claim is found to be allowable, then the withdrawn species claims will be rejoined.

Regarding the "operatively connected" limitation, applicant refers Examiner to claim 1 and figures 2, 4 and 5. Examiner considered the entire specification when the rejection was originally made. Examiner reconsidered the entire specification again and put intense focus on claim 1, and figures 2, 4 and 5. Still Examiner does not see any

support for the “operatively connected” limitation. Applicant should explain how these portions support a conclusion that the written description requirement has been complied with.

It is also argued that the Thurnauer invention is not the same as the invention as instantly claimed. There is no indication as to what specific limitation(s) Thurnauer lacks. Examiner does not see anything novel and unobvious in the present invention.

More recently it has been argued that MPEP 803 refers to an undue burden requirement. Actually MPEP 803 refers to a serious burden requirement, not undue. More importantly, MPEP 803 applies substantially only to distinct inventions – not independent inventions. **MPEP 803 states: a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search.**

MPEP 808.01(a) refers specifically to election of species: “Since the claims are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, and it is not necessary to show a separate status in the art or separate classification” (emphasis added). In other words, it is not necessary for examiner to show separate status/classification to make a prima facie showing, the mere fact that the inventions are independent establishes the prima facie showing. Of course, Applicant can overcome the prima facie showing by demonstrating that there is no serious burden. For example, by submitting evidence or showing on the record that the species are obvious variants over each other.

It is also argued that the whole basis of the traversal was that the withdrawal was in error. It is not stated what the alleged error was. Therefore there is no reason to rejoin the inventions.

It is still further argued that the features of claim 1 were searched. This is true, but it does not appear that all the species were.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

[Handwritten signature]
John Hoffmann
Primary Examiner
Art Unit 1731
11-15-04

jmh